

PATENT



06-12-08

FHJ

ATTORNEY DOCKET NO. 1906-003-Pole

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/611,548 Confirmation No.: 6763
Applicant: Douglas G. Lowenstein, et al.
Title: FINANCING OF TENANT IMPROVEMENTS
Filed: July 7, 2000 Art Unit: 3691
Atty. Docket: 1906-003-Pole Examiner: N. Subramanian

CERTIFICATE OF EXPRESS MAILING


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I hereby certify that the following:

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- Reply to Restriction Requirement
- Summary of Telephonic Interview with Examiner Subramanian
- Summary of Telephonic Interview with Examiner Kalinowski
- Love Memo of May 15, 2008

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Dated: June 10, 2008

By: 
Donna L. Angotti

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1906/003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : LOWENSTEIN, Douglas G.
Serial No.-Conf. No.: 09/611,548 - 6763
Filed : July 7, 2000
For : FINANCING OF TENANT IMPROVEMENTS
Examiner : N. Subramanian
Group Art Unit : 3691

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Name: Donna L. Angotti

Signature: 

SUMMARY OF TELEPHONIC INTERVIEW
WITH EXAMINER SUBRAMANIAN
ON MAY 30, 2008 BY DONNA L. ANGOTTI

1. On May 30, 2008, I Donna Angotti had a telephonic interview with Examiner Subramanian regarding the Restriction Requirement of January 10, 2008.

2. The interview began with me summarizing the status of discussions to date in which I explained that we had spoken previously on several occasions, and I had presented arguments that there were features claimed not found in the prior art of record. At no point did Examiner Subramanian identify prior art to be applied against any of the claims.

3. We agreed that our previous interview involved issues under 35 U.S.C § 112 and § 101. I noted that Applicant had proposed language that we believed was in compliance with §§ 112 and 101 and had submitted a paper including those proposed claims. Instead of getting a review of those claims and resolving the issues presented in previous telephonic interviews, the Examiner changed the course of action and issued a restriction requirement.

4. The Examiner stated that there was a Section 101 panel, and said that it meets once a week and that he intended to meet with it regarding the claims in this case. He said the panel meets just regarding business method patents, but other panels deal with other art areas. He said he did not know the number of people who would be on the panel and could not give me the names of the panel members. He said that examiners can not allow claims without the approval of the panel and that examiners are required to consult the panel and get approval to allow claims. Examiners are required to follow the decision of the panel. He said the requirement to consult the 101 panel before allowance was set forth in a directive sent to the examiners and issued by Director Wynn Coggins. I asked for a copy of the directive, and he said it was an internal procedure and that he did not have the authority to show it to an attorney. We agreed that I would speak with his supervisor to request a copy of the directive. I asked if there were other panels, and he said there were and that he may have given me too much information.

5. He said there were internal procedures before and after the examination. He said after examination there is an allowance conference which involves issues of §§ 112, 101 and prior art that includes the examiner, his supervisor and a few other examiners. He mentioned Quality Control.

6. I asked if he was aware of any prior art other than the art of record in this case. He said that even if another examiner has done a search before or he has searched a case before,

he still must do another search when he reviews the case again before he can allow the case. He said that there may be new art that has been issued or published or made available since the last search which may have been six months ago, for example. I asked if he meant an update search, and he said yes.

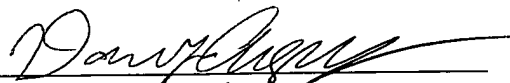
7. I asked if he was aware of any prior art that is not of record here and today, meaning May 30, 2008. He said, "No," he had not yet done an update search. He said he was not aware of any prior art that was not of record at this time. He said every time he examines a case, he does an update search as part of the procedure, and he must follow the procedures. He said some of this in response to me saying that with respect to the search, an examiner is supposed to give full faith and credit to the searches performed by other examiners and other examiners had already searched this case.

8. We discussed the restriction requirement. The issues we discussed parallel the issues raised in the written Reply to Restriction Requirement submitted herewith. He said these arguments would be considered if I presented them in a written paper. He said the feature that the leases are considered as a single lease for accounting purposes was for tax purposes and said that Group I deals with leasing, Group II deals with marketing, and Group III deals with long and short lived assets.

9. After the interview with Examiner Subramanian, I left a message for his supervisor, SPE Kalinowski, requesting a copy of the directive.

Respectfully submitted,

The Law Offices of Donna L. Angotti
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By: 
Donna L. Angotti
Reg. No. 32,679

Dated: June 10, 2008
New York, New York



1906/003

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Name: Donna L. Angotti

Signature: 

SUMMARY OF TELEPHONIC INTERVIEW
WITH EXAMINER KALINOWSKI
ON JUNE 4, 2008 BY DONNA L. ANGOTTI

1. On June 4, 2008, I, Donna Angotti, had a telephonic interview with Examiner Kalinowski regarding the directive that all claims be approved by a Section

101 panel referred to in my May 30, 2008 telephonic interview with Examiner Subramanian.

2. As background, in the interview with Examiner Subramanian, the Examiner stated that there was a Section 101 panel. He said that it meets once a week and that he intended to meet with it regarding the claims in this case. He said the panel meets just regarding business method patents, but other panels deal with other art areas. He said he did not know the number of people who would be on the panel and could not give me the names of the panel members. He said that examiners can not allow claims without the approval of the panel and that examiners are required to consult the panel and get approval to allow claims. Examiners are required to follow the decision of the panel. He said the requirement to consult the 101 panel before allowance was set forth in a directive sent to the examiners and issued by Director Wynn Coggins. I asked for a copy of the directive, and he said it was an internal procedure and that he did not have the authority to show it to an attorney. We agreed that I would speak with his supervisor to request a copy of the directive. I asked if there were other panels, and he said there were and that he may have given me too much information.

3. He said there were internal procedures before and after the examination. He said after examination there is an allowance conference which involves issues of §§ 112 and 101 and prior art that includes the examiner, his supervisor and a few other examiners. He mentioned Quality Control.

4. After the interview with Examiner Subramanian, I left a message for his supervisor SPE Kalinowski requesting a copy of the directive.

5. The telephonic interview with SPE Kalinowski on June 4, 2008 began with me requesting a copy of the directive referred to by Examiner Subramanian.

6. Examiner Kalinowski explained that there was a 101 expert panel for business methods which was composed of two SPEs and a Business Method Specialist.

The Business Method Specialist is not an examiner but is a former examiner and called a Technical Quality Assurance Specialist. He said the panel is up to date on the legal requirements. The panel gives its opinion regarding whether claims are statutory. The opinion is not written and the Examiner can disagree. The examiner writes in his search notes that he consulted with the panel and the claims were reviewed by and approved by the panel so that when the case is reviewed by Quality Control after allowance the examiner has the panel's decision to support allowance.

7. I asked if there were other panels. Examiner Kalinowski said that there were but Examiner Subramanian is a primary examiner and would not be expected to have claims reviewed for Section 112 issues. For junior examiners, the SPE reviews the claims for 112. Examiner Subramanian has a PhD in Finance and would not be expected to have claims reviewed for prior art issues.

8. Examiner Kalinowski said he did not know what directive Examiner Subramanian was referring to but suggested that it could be the John Love memo posted on the PTO website on May 29 or 30, 2008. The memo deals with process claims in view of the Federal Circuit's Comiskey decision and the Board's Bilski decision. The issue is whether process claims are statutory under Section 101. For claims to be statutory they must meet one of two tests: (1) be tied into another statutory class or (2) result in physical transformation.


9. Examiner Kalinowski stated that the requirements for Section 101 have changed and claims that were previously issued as statutory under prior tests are no longer statutory and can not meet the current tests. He provided an historic summary of the tests the PTO has used. First, there was the Safe Harbor test where there was post or pre processing activity required. Then there was the technical arts test to see if the claims claimed something useful, concrete and tangible and there was technology associated with them. Then there was the Lundgren decision that said there was no technical arts requirement. The State Street test required something useful, concrete and tangible. Now process claims must tie into another statutory class or have physical transformation.

10. I said I would look on the PTO website for the Love memo and ask Examiner Subramanian if it was what he was referring to.

11. A copy of the Love memo is attached and does not seem to be what Examiner Subramanian was referring to since it does not mention a panel at all and is by Love, not the Director Coggins. Further, it is more recently dated than my earlier discussions with Examiner Subramanian before I submitted the paper dated October 10, 2007, in which he first mentioned the 101 panel.

Respectfully submitted,

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By: 
Donna L. Angotti
Reg. No. 32,679

Dated: June 10, 2008
New York, New York



UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: May 15, 2008
TO: Technology Center Directors
FROM: John J. Love *John J. Love*
Deputy Commissioner for Patent Examination Policy

SUBJECT: Clarification of "Processes" under 35 USC § 101

Last week, the U.S. Patent & Trademark Office presented its views on subject matter eligibility of process claims to the Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130. This memo is to ensure that examiners are examining applications consistent with that view. In particular, this clarification is provided to assist examiners in determining, on a case by case basis, whether a **method** claim qualifies as a patent eligible process under 35 USC § 101. The following discussion is intended to be used in conjunction with the Interim Guidelines when evaluating whether a claimed invention falls within a statutory category of invention. (See MPEP § 2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*.)

As explained in the Interim Guidelines, the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC § 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purposes of § 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

matter that is being transformed, for example by identifying the material that is being changed to a different state.

If the claimed method is determined to be a statutory subject matter eligible process, the inquiry proceeds to determine whether the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea), as explained in detail in the Interim Guidelines. Determining whether the claimed invention is directed to a statutory category of invention is a **separate inquiry** from whether the claimed invention falls within a judicial exception and whether the invention is limited to a specific practical application of a judicial exception. A complete examination of the pending claims should be made so that all potential rejections and objections are raised normally in the first Office action on the merits. Examiners should use the criteria in this memo for the first step in the analysis for statutory subject matter eligibility of process claims under § 101 and refer to the Interim Guidelines (MPEP 2106.IV.C.) for the additional analysis with respect to determining whether a claim is directed to a judicial exception and whether the invention has a practical application.

The state of the law with respect to statutory subject matter eligibility under § 101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit. As the pending cases on appeal are decided, the Interim Guidelines will be revised to reflect any additional guidance the Office receives from the courts. Examiners are encouraged to seek assistance from their managers and pertinent training materials.